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REMARKS/ARGUMENTS

Claims 1, 2, 4-7 and 69-95 are pending.

Rejections under 35 U.S.C. § 102 or 103(a)

The Examiner has rejected claims 1, 2, 4-7, and 69-95 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over WO 98/51662 (in particular the generic structure on page 24).

WO 98/51662 does not identically disclose or even suggest the two compounds recited in the pending claims. From the generic structure on page 24 of WO 98/51662, one of ordinary skill in the art would not have been motivated to select the specific compound recited in claim 1. Moreover, there would have been no motivation from the generic structure on page 24 of WO 98/51662 to select the compound having the specific stereochemistry of the compound recited in claim 2. There is no suggestion of the specifically claimed compounds in the applied art.

The structure on page 24 of WO 98/51662 provides a broad genus of possible compounds with five different variables, each of which independently may vary considerably. There would have been no motivation from considering the broad genus disclosed in WO 98/51662 to make the specifically claimed compounds, or to select the specific combination of substituents provided in the two compounds recited in the claims. One of ordinary skill in the art would not have been motivated to pick and choose amongst the many possible substituents and combinations of substituents to select the two particular compounds recited in the claims. There is also no disclosure or suggestion of the embodiments of the pharmaceutical compositions or methods recited in the claims.

The fact that a claimed compound may be encompassed by a disclosed generic formula of a reference does not by itself render a claimed compound obvious and unpatentable. See *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). As was held in *In re Baird*, the disclosure of a large number of compounds of a genus does not necessarily render obvious the selection of a specific compound of the genus, particularly when there is no motivation to select the particular compound in the cited reference.

The generic structure on page 24 of WO 98/51662 includes 5 variables, R_a, R_b, R_c, R_d and Z. Each of R_a, R_b, R_c and R_d can independently vary from amongst at least 11 different possible groups, including alkyl, aryl, alkaryl, and heteroaryl, wherein the possible groups are themselves a class with many different members falling within each listed class. Similarly, Z can vary from amongst at least 13 different groups, including alkyl, alkenyl, alkynyl, etc. which themselves include many different possible groups. Thus, the possible individual compounds within the scope of the generic description is exponentially large. From the broad disclosure in the reference, there is no motivation to select the particular substituents of the compound recited in the claims, where, in combination, R_a, R_b, R_c and R_d are t-butyl, and Z is CH₂CH(OH)CH(OH)CH(OH)COOH. There is no suggestion within the reference itself to make such a selection, as is required for a proper rejection under 35 U.S.C. § 103, nor is such a selection identically disclosed in the cited reference as is required for a proper rejection under 35 U.S.C. § 102(b).

As stated *In re Baird*, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. See also *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has

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"decline[d] to extract from *Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

Since there is no motivation within the cited reference to make the compounds defined by the specific limitations of the claims, Applicant requests that this rejection be withdrawn.

In view of the above arguments, Applicants respectfully submit that the claims are in condition for allowance, and such action is respectfully requested.

Applicant petitions for any required relief, and the Commissioner is authorized to charge any additional fees not attached herewith or credit any overpayment to deposit account no. 11-0980, referencing Docket No.: 04676-105059.

Respectfully submitted,

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By


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K&S Docket No. 04676.105059 (ATH 113US)



CERTIFICATE OF MAILING UNDER 37 CFR § 1.8 (a)

I hereby certify that this Response to Office Action and Petition for Three Month Extension of Time, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 9, 2003.

A handwritten signature in black ink, appearing to read "Tisha Hardwick".

Tisha Hardwick